

REMARKS

With the addition of claims 9 to 15, claims 1 to 15 are now pending.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicant thanks the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

Claims 1, 4, 5, and 8 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,226,747 ("Larson").

Claim 1 as presented relates to a device for preventing pirated copies of computer programs for use with a computer, the device including input and output devices for bidirectional data exchange with the computer, a first memory element containing a data file that is transferrable to the computer via the output device, and a second memory element into which data is writable by the input device, and further provides that the data file transferrable to the computer includes a key. In this regard, the present application provides, for example, the following:

[A] data file containing an electronic key is transferred from the device to the computer. The data file is then only on the computer. As an alternative, the data file may also be copied from the device to the computer and then erased on the device.

The Larson reference, by contrast, relates to a method and device for limiting the number of installations of a computer software program using a read-only storage device, such as a compact disk (CD), which includes the computer software program to be transferred to the computer, and an accompanying removable read/write storage memory device inserted into the computer during the installation procedure, such as a floppy disk, which contains information linking it with a particular CD, such as a software serial number or software version identifier. (See Larson, Abstract, col. 3, lines 42 to 50, and col. 8, lines 20 to 28). The floppy disk also includes further information stored in an archive information file after each installation of the software program that identifies each computer upon which the software program was installed (i.e., a "data fingerprint"). (See Larson, col. 8, lines 50 to 64).

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In this regard, installation of the computer software program is authorized by verifying the link between the CD and the floppy disk and then comparing the identification information of the computer to the identification information previously stored on the floppy disk. (See Larson, col. 3, lines 53 to 57). If the identification information of the computer has not been previously stored on the floppy disk, and if the computer software program has not been installed in excess of the limits of the license as indicated by the number of computer for which identification information is stored in the archive information file of the floppy disk, the installation of the computer software program from the CD to the particular computer is allowed. (See Larson, col. 3, lines 57 to 62). If, on the other hand, the linked floppy disk is not present or the number of computers for which identification information stored in the archive information file reaches the predefined limit, the installation is disallowed. (See Larson, col. 3, lines 62 to 65).

In this regard, it is respectfully submitted that any data or data file resident on either the CD or the floppy disk regardless of its contents is never "transferred" to the computer in the manner contemplated by claim 1, but instead is merely read so that the data or data file remains on the CD or floppy. Indeed, even the computer software program remains on the "read-only" CD after installation. Accordingly, for at least this reason, it is respectfully submitted that Larson does not identically disclose or suggest, a datafile that is transferable to a computer, and includes a key, as in claim 1 -- as it must to support an anticipation rejection. It is therefore respectfully submitted that claim 1 as presented is allowable for at least these reasons.

Claim 4 depends from claim 1, and is therefore allowable for at least the same reasons as claim 1.

Claims 5 and 8 as presented include features analogous to those of claim 1, and are therefore allowable for essentially the same reasons as claim 1.

Claims 6 and 7 depend from claim 5, and are therefore allowable for at least the same reasons as claim 5.

In sum, it is respectfully submitted that claims 1 to 8 are allowable for at least the reasons discussed above. Withdrawal of the anticipation rejections with respect to Larson is therefore respectfully requested.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden

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of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

With respect to the rejection of claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Larson in view of U.S. Patent No. 6,523,119 (“Pavlin”), it is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the secondary Pavlin reference does not cure the critical deficiencies of the Larson reference (as explained above) with respect to claim 1, from which claims 2 and 3 ultimately depend. Indeed, the Office Action does not allege that Pavlin cures the deficiencies of Larson as applied against claim 1. It is therefore respectfully submitted that claims 2 and 3 are allowable for at least the same reasons that claim 1 is allowable. Accordingly, withdrawal of the obviousness rejections of claims 2 and 3 is respectfully requested.

As further regards the obviousness rejections of claims 2 and 3, to the extent that the Examiner maintains the unsupported “ordinary skill” statements regarding those rejections, it is respectfully requested pursuant to 37 C.F.R. § 1.104(d)(2) that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also M.P.E.P. § 2144.03). Otherwise, if the Examiner cannot provide either references or an affidavit to support the contentions now made, it is respectfully requested that the obviousness rejections of the claims be withdrawn for this reason alone.

New claims 9 to 15 do not add any new matter and are supported in the specification. The new claims 9 to 12 depend from claim 1 and it is respectfully submitted that these claims are allowable at least for the same or essentially the same reasons discussed

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above with respect to claim 1. New claim 13 includes features analogous to those of claim 1, but is directed to further defining the claimed subject matter in view of the embodiments described in the present application. Accordingly, claim 13 is allowable for essentially the same reasons as claim 1, as are its dependent claims 14 and 15.

In summary, it is respectfully submitted that all of claims 9 to 15 of the present application are allowable at least for the foregoing reasons.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn since they have been obviated. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

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Respectfully submitted,
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